

Appl. No.: 10/767,471
Atty. Docket No.: CL1505ORD

REMARKS

Status of the claims

By entry of the above amendment, claims 36, 39, 46, 49, 56, and 59 are hereby amended, and claims 1, 27-35, 37-38, 47-48, and 57-58 are canceled (claims 2-26 were previously canceled). As such, claims 36, 39-46, 49-56, and 59-65 are currently pending and under examination.

No new matter has been added by this amendment.

All of the amendments and cancellations to the claims submitted in this response are being made without disclaimer or prejudice, and Applicants reserve the right to pursue the subject matter that was encompassed by the claims, prior to any claim amendments or cancellations, in subsequent continuation or divisional applications.

New Claim Objections

The Examiner objected to claims 27, 37, 47, and 57 for the specific recitation of non-elected subject matter. The Examiner also objected to claims 29, 39, 49, and 59 over the recitation of the phrase "the genomic sequence of PTPN22 gene", where the phrase "the genomic sequence of the PTPN22 gene" is correct.

To expedite prosecution, claims 27, 37, 47, and 57 are hereby canceled, without disclaimer or prejudice, thus making this rejection moot with respect to these claims.

Claims 39, 49, and 59 are hereby amended in accordance with the Examiner's suggestion (claim 29 is hereby canceled, as indicated below in response to the rejection under 35 USC §112, second paragraph, indefiniteness).

New Claim Rejection: 35 USC §112, second paragraph, indefiniteness

The Examiner rejected claims 1 and 27-45 as being unclear over recitation of the phrase "detecting the presence of a single nucleotide polymorphism". The Examiner also rejected claim 32 as being unclear because there is not proper antecedent basis for any "biological sample".

To expedite prosecution, claims 1 and 27-35 are hereby canceled, without disclaimer or prejudice, thus making this rejection moot with respect to these claims.

Claim 36 is hereby amended to specify a specific nucleotide, thereby obviating this rejection with respect to claims 36-45.

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New Claim Rejection: 35 USC §112, first paragraph, written description (new matter)

The Examiner rejected claims 1, 29-31, 33-36, 39-46, 39-56, and 59-65 because allegedly neither the specification nor claims as originally filed contemplate methods for the identification of risk of the specific subgenus of "autoantibody-positive autoimmune" diseases.

To expedite prosecution, claims 36, 46, and 56 are hereby amended, without disclaimer or prejudice, to replace "autoantibody-positive autoimmune" diseases with "RF-positive rheumatoid arthritis" (and dependent claims 28, 38, 48, and 58 are hereby amended to maintain proper antecedent basis), thereby obviating this rejection.

Maintained Claim Rejection: 35 USC §112, first paragraph, written description

The Examiner rejected claims 1 and 27-45 for allegedly being not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

As indicated above in response to the rejection under 35 USC §112, second paragraph (indefiniteness), claims 1 and 27-35 are hereby canceled (thus making this rejection moot with respect to these claims) and claim 36 is hereby amended to specify a specific nucleotide (thereby obviating this rejection with respect to claims 36-45).

Maintained Claim Rejection: 35 USC §112, first paragraph, scope of enablement

The Examiner rejected claims 1 and 27-65 because the specification, while being enabling for certain scope (as indicated by the Examiner in the Office Action of 12/19/07, such as at page 9; 1st paragraph, of that Office Action), allegedly does not reasonably provide enablement for methods comprising correlating any other nucleotide content at position 101 of SEQ ID NO:36,673 with any autoantibody-positive autoimmune disease other than RF+ RA.

In response, Applicants respectfully assert that this scope of enablement rejection has now been fully addressed by the remarks and amendments made in response to the other rejections discussed above, as follows:

With respect to the aspect of the scope of enablement rejection relating to any nucleotide content at position 101 of SEQ ID NO:36,673 and any altered risk, claims 1 and 27-35 are hereby canceled and claim 36 is hereby amended to specify a specific nucleotide (as indicated above in response to the rejection under 35 USC §112, second paragraph (indefiniteness)). Furthermore,

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claims 46 and 56 already specify specific nucleotides, and claims 36, 46, and 56 already specify either increased or decreased risk corresponding to each nucleotide.

With respect to the aspect of the scope of enablement rejection relating to any autoantibody-positive autoimmune disease, claims 36, 46, and 56 are hereby amended to replace "autoantibody-positive autoimmune" diseases with "RF-positive rheumatoid arthritis" (as indicated above in response to the rejection under 35 USC § 112, first paragraph, written description (new matter)).

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 USC § 112, first paragraph, scope of enablement.

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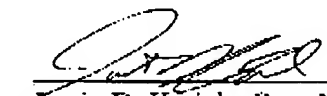
Conclusions

In conclusion, in light of the amendments and remarks above, Applicants submit that the present application is fully in condition for allowance. Early notice to that effect is earnestly requested.

The Examiner is invited to contact the undersigned via telephone if a phone interview would expedite the prosecution of the instant patent application.

Respectfully submitted,

By:


Justin D. Karjala, Reg. No.: 43,704

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Celera
1401 Harbor Bay Parkway
Alameda, CA 94502
Tel: 510-749-4224
Fax: 510-749-4266